

REMARKS

Claims 1-27 are pending in the present application. In response to the above-identified Office Action, Applicants have amended the application and respectfully request reconsideration thereof. In this response, claims 1-27 have been cancelled, and new claims 28-37 have been added. Applicants respectfully submit that the cancellation of the above-identified claims are not done to overcome the rejections of these claims by the Examiner but rather to expedite the prosecution of the present application and to emphasize and concisely claim the various features of the present invention in the new claims 28-37.

Rejections under 35 U.S.C. §102 and §103

Claims 1-3, 5-11, 13, 15-20, 22, 23, and 25-27 have been rejected under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 5,608,779 to Lev et al. (hereinafter referred to as Lev).

Claims 4, 12, and 24 have been rejected under 35 U.S.C. §103(a) as being unpatentable over Lev in view of U.S. Patent No. 5,845,211 to Roach, Jr. (hereinafter referred to as Roach).

To anticipate a claim, the prior art reference must teach every element of the claim. A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. Verdegaal Bros. v. Union Oil of California, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987).

To establish a *prima facie* case of obviousness, the prior art reference (or references when combined) must teach or suggest all the claim limitations. “The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in Applicants’ disclosure.” In re Vaeck, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

In this response, claims 1-27 have been cancelled and new claims 28-37 have been added.

Applicants respectfully submit that new claims 28-37 are neither anticipated nor rendered obvious by Lev and/or Roach, for the reasons and explanations set out below.

As to the new claim 28, Applicants respectfully submit that Lev and Roach do not teach, disclose, or suggest all the elements and features of claim 28. In particular, Lev and Roach do not teach or suggest the following element of claim 28:

“converting the vocoded data into tones and routing the tones through a wire-based telephone system to the second subscriber unit if the second subscriber unit is part of a second wireless telephone system.”

Lev discloses a communication system having switching center configurations which detect the occurrence of a mobile-to-mobile call using control messages. In particular, Lev discloses that, when a call is mobile-to-mobile, a switching center instructs transcoders to operate in a transparent mode (Lev, Abstract, Figure 1, Col. 4, lines 11-29, Figure 5, Col. 6, line 11 – Col. 7, line 23). While operating in the transparent mode, the transcoders do not convert compressed digital voice to non-compressed digital voice and vice versa but allow the compressed digital voice to pass through (Lev, Abstract, Col. 4, lines 11-29, Col. 5 – Col. 6).

Roach discloses a wireless Integrated Services Digital Network (WISDN) which includes intelligent cellsites (ICSs), a central site controller (CSC), a billing aggregator, etc. that are interconnected to the PSTN (Roach, Abstract, Figures 1-4A, Col. 3 – Col. 4). According to Roach, the ICSs communicate with users who request services via radio communication and that, when a call to the user is initiated from a PSTN subscriber, the PSTN service control point may access the CSC, which provides authentication services and routing information (Roach, Abstract, Col. 3 – Col. 4).

However, after study of the prior art references cited by the Examiner, Applicants are unable to find any disclosure or suggestion in Lev and Roach which is directed to above-recited feature of the new claim 28. Lev and Roach do not show, suggest, or provide any motivations for a method or system in which vocoded data from a first subscriber unit in a first wireless telephone system is converted into tones and routed through a wire-based system to a receiving subscriber unit that is part of a second wireless system. Specifically, the sections of Lev that are cited by the Examiner (e.g., Figures 1, 2, 5, and the corresponding descriptions, etc.) do not provide any information or suggestion from which the above-recited feature of the new claim 28

can be obtained or derived. Accordingly, Applicants respectfully submit that the new claim 28 is neither anticipated nor rendered obvious by Lev and/or Roach.

Since new claims 29-30 depend from claim 28 and include additional limitations, Applicants respectfully submit that claims 29-30 are also not anticipated or rendered obvious by Lev and/or Roach.

With respect to the new claims 31-37, Applicants respectfully submit that these claims are neither anticipated nor rendered obvious by Lev and/or Roach, for the reasons and explanations provided above with respect to the amended claim 28. In particular, Lev and Roach do not disclose or suggest any apparatus or system for converting vocoded data from a subscriber unit that is part of a first wireless system into tones and deliver the tones through a wire-based system to a receiving subscriber unit that is part of a second wireless system.

Accordingly, Applicants respectfully submit that the new claims 28-37 are in a condition for allowance.

Double Patenting Rejection

Claims 9, 14, and 18-21 have been rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 3 of U.S. Patent No. 6,292,662 because they are not patentably distinct from each other. The Examiner has indicated that a timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground. In view of the cancellation of these claims in this response, it is no longer necessary to address this rejection.

REQUEST FOR ALLOWANCE

In view of the foregoing, Applicants submit that all pending claims in the application are patentable. Accordingly, reconsideration and allowance of this application are earnestly solicited. Should any issues remain unresolved, the Examiner is encouraged to telephone the undersigned at the number provided below.

Respectfully submitted,

Dated: 10/31/2003

By: Michael D. Graham, Jr.
Reg. # 51,751
Thien T. Nguyen, Reg. No. 43,835
(858) 651-6137

QUALCOMM Incorporated
5775 Morehouse Drive
San Diego, California 92121
Telephone: (858) 651-4125
Facsimile: (858) 658-2502